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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,443	12/09/2004	Yusuke Shimizu	05905-0179	8650
22852	7590	10/05/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER WONG, JEFFREY KEITH	
			ART UNIT	PAPER NUMBER
			3714	
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			10/05/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,443

Applicant(s)

SHIMIZU ET AL.

Examiner

Jeffrey K. Wong

Art Unit

3714

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 20 and 24-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 20, 24-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

1. This Office-Action acknowledges the Amendment filed on 6/23/2009 and is a response to said Amendment.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18, 20, 24-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benoy, US Patent 6,896,618(Benoy) in view of Kirmse et al., US 2008/0171601 (Kirmse).

Regarding Claim 18, 24, 26.

Benoy teaches a game system including an arcade game machine installed in a play facility with which a player plays a game after paying a play fee(Col 1, lines 20-34.

Casino games require a player to pay a fee to play), and a server device connected to the arcade game machine via a network(Abstract. The loyalty program server is connected to the gaming machine), the game system being configured to perform:

- (a) registering identification information unique to the player on the server device (Abstract. Players must enter identification information before playing a game);
- (c) allowing the player to play the game on the arcade game machine when the

identification information transmitted from the player meets the identification information stored on the server(Col 8, 1-3. Players will be able to play the game and accumulate loyalty points after validating their identification), wherein the arcade game machine includes an interface for recording the identification information of the player, and authenticates the identification information registered on the server device (Col 2, lines 25-35. In this case, it is obvious that the gaming machine would require an interface in order to allow players to register for a tracking account for use with a cardless tracking system):

Benoy failed to disclose:

(b) after the registering, allowing the player to store on the server device an optional message in advance in association with the registered identification information and in association with an event associated with a game result of the game to be played, which is designated by the player who expects the event to occur during a progress of the game to be played before allowing the player to start the game on the arcade game machine, said optional message being arranged to be sent from the server device to a terminal device optionally designated in advance by the player

(d) transmitting the optional message from the server device to the terminal device optionally designated in advance by the player so that the optional message is displayed on the terminal device when the event has occurred on the arcade game machine during the progress of the game after starting the game, wherein the optional message to be displayed on the terminal device is associated with the game result after the game has been played in response to input from the player.

However, Kirmse teaches of a game and messenger client-server system is provided that includes a plurality of game clients, a game server, a plurality of messenger clients, and a messenger server(Abstract) where it is well known with the advent of the global inter-network of networks generally referred to as "the Internet," communication between users connected to the Internet has been facilitated by programs such as email and instant messaging (para 3). Kirmse also teaches that if a buddy logs on with their messenger client, each buddy is notified of the new state (e.g., "logged on").If one of those notified buddies is in a game, that buddy's messenger will send back a message to the newly logged on user with the game information so the newly logged on buddy will have the information to display a game icon, invoke a game, etc.(para 68). Kirmse also teaches of an optional messaging system such that when an invitee messenger client receives a message that a buddy is playing a game, the invitee messenger client decodes the message as needed to invoke the game and optionally send a message to the census process(para 71). This messaging system is used for coupling a game client to a messenger client to allow the game client to send the messenger client data used to initiate joining a game, whereby a message sent by the messenger client includes the data used to initiate joining a game. Also, logic is included for initiating a join of a game at an invitee client, using data received in a message to the invitee(Abstract). Kirmse also goes on to teach that messages of game results in response to input from the player (para 4 and 46. In this case, the results of a player discarding cards is being displayed for other players to see. Also, when a client ends a game or terminates a game client, the game client might also include code that

might cause the messenger client to send a message indicating the new state "out of game" which is viewed as input from a player because a player would need to input the termination of the game client which will result in the game client's termination.)

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art to implement Kirmse's messaging system teachings with Benoy's loyalty program system as means of allowing players to invite others into joining their games as taught by Kirmse.

Regrading Claim 20.

Kirmse teaches calculating points acquired as a result of the player's game play, wherein the optional message to be displayed on the terminal device is stored on the server device in association with a certain value of points to be acquired by the player before starting the game.(para 53, 69-70 and 97. In this case, the point system in which is calculated is represented by the "1" which would represent the flagging of the player which would mean the player is online and playing a game in where another player can join), wherein plural ones of the optional messages are stored in relation with certain values of game points, respectively, one of which is given to the player in accordance with a game result executed by the player (para 53. In this case, the "available" smiley icon which is associated with the flagging that a character is available is the optional message being displayed. Messages are sent out according to the flagging of the player's availability.).

Regrading Claim 25.

Kirmse teaches wherein said optional message contains plural messages which are stored in relation with certain game stages or statuses as said event designation in advance by the player, respectively(para 97. Players can elect to send messages that allow friends to find them or decline all invitations or send out invitations.)

Regarding Claim 27.

Benoy teaches wherein said designated terminal device is the arcade game machine on which the player plays the game(Abstract. Players play at the designated machine in which said player enters identification information).

Regarding Claim 28.

Benoy teaches wherein said designated terminal device is either another arcade game machine on which an opponent player plays the game or a mobile terminal device which the opponent player carries(Col 5, lines 26-28).

Regarding Claim 29.

Benoy teaches wherein said designated terminal device is the one of the plurality of game apparatuses on which the player plays the game (Col 4, line 22).

Regarding Claim 30.

Benoy teaches wherein said designated terminal device is either another of the plurality

of game apparatuses on which an opponent player plays the game or a mobile terminal device which the opponent player carries(Col 5, lines 26-28).

Regarding Claim 31.

Benoy teaches wherein said designated terminal device is either the other of the plurality of game apparatuses on which the other player plays the game or a mobile terminal device which the other player carries.

Regarding Claims 32, 33.

Benoy teaches a game system comprising a server (abstract) and a plurality of game apparatuses (Col 4, line 22) connected via a network(Col 5, lines 56-57), which is configured to allow one player to play a game on one of the plurality of game apparatuses against another player playing on another of the plurality of game apparatuses(Col 4, lines 54-64. Bingo is played against another player), said game system being configured to perform:

(a) registering identification information unique to each player (Abstract. Players must input identification information) so that the one player on the one of the plurality of game apparatuses can play the game against the another player on the another of the plurality of game apparatuses, wherein the game system includes an interface for recording the identification information of the player, and authenticates the identification information registered on the server (Col 2, lines 25-35. In this case, it is obvious that

the gaming machine would require an interface in order to allow players to register for a tracking account for use with a cardless tracking system):

Benoy failed to disclose:

(b) allowing the one player to store on the server an optional message in advance by way of a mobile terminal device operated by the one player, said optional message being a message arbitrarily prepared or designated by the one player, stored on the server in relation to the registered identification information and in relation to an event associated with a game result of the game to be played, which the one player expects to occur during a progress or as a result of the game, and arranged to be displayed on a terminal device designated in advance by the player; wherein the optional message to be displayed on the terminal device is associated with the game result after the game has been played in response to input from the player, wherein the optional message to be displayed on the terminal device is associated with the game result after the game has been played in response to input from the player.

(c) transmitting the optional message to said designated terminal device from the server so that the message is displayed on the designated terminal device when the event designated in advance by the one player has occurred during a progress or as a result of the game after starting the game, wherein the optional message to be displayed on the terminal device is associated with the game result after the game has been played in response to input from the player.

However, Kirmse teaches of a game and messenger client-server system is provided that includes a plurality of game clients, a game server, a plurality of

messenger clients, and a messenger server(Abstract) where it is well known with the advent of the global inter-network of networks generally referred to as "the Internet," communication between users connected to the Internet has been facilitated by programs such as email and instant messaging (para 3) and where it is also well known that the implementation of the system on computer systems can be Internet-connectable computers (desktop computers, laptop computers, palm-sized computers, wearable computers, set-top boxes, embedded TCP/IP clients, wireless phones with a user interface, and the like.(para 29). Kirmse also teaches that if a buddy logs on with their messenger client, each buddy is notified of the new state (e.g., "logged on").If one of those notified buddies is in a game, that buddy's messenger will send back a message to the newly logged on user with the game information so the newly logged on buddy will have the information to display a game icon, invoke a game, etc.(para 68). Kirmse also teaches of an optional messaging system such that when an invitee messenger client receives a message that a buddy is playing a game, the invitee messenger client decodes the message as needed to invoke the game and optionally send a message to the census process(para 71). This messaging system is used for coupling a game client to a messenger client to allow the game client to send the messenger client data used to initiate joining a game, whereby a message sent by the messenger client includes the data used to initiate joining a game. Also, logic is included for initiating a join of a game at an invitee client, using data received in a message to the invitee(Abstract). Kirmse also goes on to teach that messages of game results in response to input from the player (para 4 and 46. In this case, the results of a

player discarding cards is being displayed for other players to see. Also, when a client ends a game or terminates a game client, the game client might also include code that might cause the messenger client to send a message indicating the new state "out of game" which is viewed as input from a player because a player would need to input the termination of the game client which will result in the game client's termination.)

Therefore, it would have been obvious at the time of the invention to one of ordinary skill in the art to implement Kirmse's messaging system teachings with Benoy's loyalty program system as means of allowing players to invite others into joining their games as taught by Kirmse.

Regarding Claim 34.

Benoy and Kirmse disclose the game system of claim 18. Kirmse teaches wherein the optional message is displayed on arcade game machines of other game players playing the same game (para 31. Accord to some embodiments described herein, a game client and a messenger client operate to present a user with graphical information on a user interface for playing a game as well as notifying other friends of one's action of playing a game.)

Response to Arguments

4. Applicant's arguments filed 6/23/2009 have been fully considered but they are not persuasive. Applicant alleges:

"Applicants respectfully traverse the rejection of claims 18, 20, and 231-33 under 35 U.S.C. § 103(a) as being unpatentable over the cited art. The cited art fails to teach or suggest each and every feature of Applicants' amended independent claims 18, 24, 26, 32, and 33. Specifically, Applicants respectfully submit that amended independent claims 18, 24, 26, 32, and 33 are allowable because neither Benoy, nor Kirmse, taken alone or in any reasonable combination, teaches or suggests, at least Applicants' claimed "(d) transmitting the optional message from the server device to the terminal device optionally designated in advance by the player so that the optional message is displayed on the terminal device when the event has occurred on the arcade game machine during the progress of the game after starting the game, wherein the optional message to be displayed on the terminal device is associated with the game result after the game has been played in response to input from the player," as recited in amended independent claim 18, and similarly recited in amended independent claims 24, 26, 32, and 33."

The Examiner disagrees. Kirmse teaches displaying messages of game results in response to input from the player in para 4. In this case, the result of a player discarding cards is being displayed for other players to see. Also, para 46 teaches that when a player ends a game or terminates a game client, the game client might also include code that might cause the messenger client to send a message indicating the new state "out of game" which is viewed as input from a player because a player would need to input the termination of the game client which will result in the game client's termination.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey K. Wong whose telephone number is (571)270-3003. The examiner can normally be reached on M-Th 8:30am-7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hotaling can be reached on (571)272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John M Hotaling II/
Primary Examiner, Art Unit 3714

JKW